

REMARKS

Claims 1-24, 26-35, and 37-41 are pending. Claims 1-3, 5-16, 27, and 38-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,063,500 to Shorter. Claims 4, 26, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,063,500 to Shorter. Claims 17, 20-24, 28, and 31-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,063,500 to Shorter in view of U.S. Patent No. 6,704,764 to Ottati and U.S. Patent Publication No. 2005/0060704 to Bulson et al. Claims 18-19 and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,063,500 to Shorter in view of U.S. Patent No. 6,704,764 to Ottati, U.S. Patent Publication No. 2005/0060704 to Bulson and U.S. Published Patent Application No. 2002/0013827 to Edstrom et al.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 42-49 are added. Claims 1-24, 26-35, and 37-49 remain in the case for consideration.

On March 17, 2009, the undersigned held a short conversation with Examiner Lai. Examiner Lai suggested that the claims needed some amendments. Specifically, Examiner Lai suggested that claim 1 needed to be amended to recite “at least one service” instead of “a service”, as Examiner Lai thought that “a service” limited the claimed invention to a single service. The undersigned pointed out that devices that met the features of claim 1 but offered multiple services would still infringe claim 1, and that “a service” did not limit the offered services to just the first service.

Examiner Lai also suggested that claim 16 is incomplete, as there is no description what would happen if the requested service is not in the list of services offered. The undersigned pointed out that even though claim 16 did not indicate what would happen if the requested service was not in the list of services, claim 17 described this situation. Further, claim 16 is not unclear just because there is no indication what would happen if the requested service was not in the list of services. A person of ordinary skill in the art would understand the claim without that description.

The undersigned also pointed out that Examiner Lai’s suggested amendments did not appear to make the claims patentable over the prior art of record, and only addressed issues under 35 U.S.C. § 112, ¶ 2: issues that Examiner Lai had not raised by rejecting the claims. If Examiner Lai thought the claims were indefinite, the Examiner should have issued a rejection under 35 U.S.C. § 112, ¶ 2, and that such a rejection would necessitate a new non-

final Office Action (as the claim features in question were in the claims as originally filed).

37 C.F.R. § 1.104 states:

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. **The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed**, as well as with respect to matters of form, unless otherwise indicated. . . .

(b) *Completeness of examiner's action.* **The examiner's action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable. . . .

(emphasis added).

Given the requirements of 37 C.F.R. § 1.104, the Examiner should raise issues under 35 U.S.C. § 112, ¶ 2 as soon as the Examiner is aware of these issues. Otherwise, the Examiner's action is incomplete. As the Examiner was aware of these "issues" before the filing of this Amendment (given that the Examiner presented them to the Applicant over the telephone on March 17, 2009), the Examiner should formally present these issues to the Applicant in an Office Action. This means the Examiner should voluntarily withdraw the current final Office Action and issue a new Office Action presenting these "issues" under 35 U.S.C. § 112, ¶ 2. And since these "issues" are directed to a new ground of rejection not necessitated by the Applicant's amendment (as the claim features in question were in the claims as originally filed), this new Office Action should not be made final. To wait for the Applicant to file a Request for Continued Examination and then raise these new "issues" is contrary to the Examiner's obligations and unfair to the Applicant. As the Examiner is unwilling to withdraw the current Office Action, the Applicant expects that the Examiner will not issue rejections under 35 U.S.C. § 112, ¶ 2 in the next action.

REJECTIONS UNDER 35 U.S.C. § 102(b)

The Applicant continues to believe that claims 1-3, 5-16, 27, and 38-41 are patentable under 35 U.S.C. § 102(b) over Shorter, for the reasons previously argued. If Shorter teaches virtual machines offering services, then because Shorter assigns requests to virtual machines based on the process ID and/or thread ID, every virtual machine in Shorter must offer every service. Further, Shorter does not teach a database of service provider data, or a list of

services offered by each virtual machine (if every virtual machine offers every service, then the list of services offered by each virtual machine is the same). The Applicant also questions whether Shorter expressly teaches a single virtual machine offering multiple services, and the Applicant does not believe that it is inherent in Shorter to select a combination of software packages to define a new virtual machine or to identify the new virtual machine as offering the selected services.

REJECTIONS UNDER 35 U.S.C. § 103(a)

The Applicant continues to believe that claims 4, 17-24, 26, 28-35, and 37 are patentable under 35 U.S.C. § 103(a) over Shorter, potentially in view of Ottati, Bulson, and Edstrom. The Applicant believes the combination of Shorter with Ottati accomplishes nothing, and that Shorter teaches away from the proposed combination with Ottati. The Applicant also believes that the combination of Shorter with Edstrom (and Ottati and Bulson) does not teach a list of services offered by the virtual machines.

NEW CLAIMS

New claims 42, 44, 46, and 48 recite that the selection of the virtual machine is responsive to the requested service. As argued previously, Shorter selects the virtual machine based solely on the process ID and/or the thread ID. As a result, Shorter does not teach the concept of selecting the virtual machine based on the service requested, as recited in new claims 42, 44, 46, and 48. Further, Shorter teaches away from the features of new claims 42, 44, 46, and 48, and therefore new claims 42, 44, 46, and 48 are not obvious over Shorter in view of any other references.

New claims 43, 45, 47, and 49 recite that the set of virtual machines includes a virtual machine that does not offer the first service. As a consequence, this virtual machine that does not offer the first service cannot be the selected virtual machine in new claims 42, 44, 46, and 48. Again, if the virtual machines of Shorter offer services, and if Shorter selects virtual machines based on the process ID and/or thread ID and not based on the requested service, it is necessary that the virtual machines of Shorter offer every service, and so there cannot be a virtual machine that does not offer the first service. This means that Shorter does not teach the features of new claims 43, 45, 47, and 49, and teaches away from the features of these new claims, so new claims 43, 45, 47, and 49 cannot be anticipated by or obvious over Shorter.

The Applicant also respectfully points out that new claims 43, 45, 47, and 49, despite reciting negative limitations, are not indefinite under 35 U.S.C. § 112, ¶ 2. According to M.P.E.P. § 2173.05(i), “there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph”. Further, M.P.E.P. § 2143.03 states that “All words in a claim must be considered in judging the patentability of that claim against the prior art” (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)), which includes negative limitations. Therefore, it would be improper to reject new claims 43, 45, 47, and 49 as indefinite for reciting negative limitations, and therefore give no weight to these claim features.

For the foregoing reasons, reconsideration and allowance of claims 1-24, 26-35, and 49 of the application as amended is requested. **The Applicant requests the Examiner to call the undersigned at (503) 222-3613 to schedule an interview regarding the prior art references at the Examiner's earliest convenience, and preferably before the Examiner issues the next Office Action, as the Applicant believes an interview would be helpful in advancing the case.**

Respectfully submitted,

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